

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAO OGAWA, TOSHIRO OHTSUBO and SHIGENORI TSUDA

Appeal No. 94-4145
Application No. 07/882,252¹

HEARD: October 17, 1997

Before SMITH, WEIFFENBACH, and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

Masao Ogawa et al. (appellants) appeal from the examiner's final rejection of claims 1 through 5, which are all of the claims remaining in the application.

Claims 1 and 4 are representative of the subject matter on appeal and read as follows:

¹ Application for patent filed May 8, 1992. According to the appellants, the application is a continuation of Application No. 07/558,454, filed July 27, 1990.

Appeal No. 94-4145
Application No. 07/882,252

1. A water dispersible granule which is obtained by granulating a mixture comprising a pesticide having a melting point of not more than 70°C, a calcined product of precipitated hydrated silicon dioxide and a surface active agent by the wet extrusion-granulation method or compaction method.

4. The water dispersible granule of claim 1, which further comprises a pesticide having a melting point of more than 70°C.

The references of record relied upon by the examiner are:

Chan	4,753,957	Jun. 08,
1988		

European Patent Application having a publication number 0 106 164, Yukikazu et al., April 25, 1984 (hereinafter referred to as "Yukikazu")²

Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of Yukikazu and Chan.

We affirm. However, because our reasoning is materially different from that expressed by the examiner and because our reasoning relies on appellants' admission at page 1 of the specification for the first time, we will denominate our affirmance as a new ground of rejection to afford appellants

² The examiner refers to this reference as "Sumitomo".

Appeal No. 94-4145
Application No. 07/882,252

the procedural safeguards associated with 37 CFR § 1.196(b).
Our reasons for these determinations follow.

As evidence of obviousness of the claimed subject matter.
under 35 U.S.C. § 103, the examiner relies on the combined
teachings of Yukikazu and Chan. The Yukikazu reference
describes insecticidal wettable powders containing 10% to 80%
of an insecticide of liquid state at room temperature, about
3.33 % to about 27% of a calcined synthetic hydrated silicon
dioxide and a surface active agent, such as lignosulfonates.
See page 1, lines 1-6, page 3, lines 1-26 and page 4, lines
4-8. In example 10 at page 8 of Yukikazu, wettable powders
having 55 parts of malathion (insecticide), 40 parts of
calcined white carbon (calcined synthetic hydrated silicon
dioxide) and 5 parts of surface active agents (sulfonates) are
specifically formed. Optionally, a diluent can be added
together with calcium carbonate or grape sugar during the
formation of the wettable powders. See the paragraph bridging
pages 3 and 4. Appellants also do not dispute that the
Yukikazu reference at page 4, lines 16-20, suggests adding an
additional insecticide which has a melting point as high as
80°C. Compare page 4 of the Answer with the Brief and the

Appeal No. 94-4145
Application No. 07/882,252

Reply Brief in their entirety. Although the Yukikazu reference, as argued by appellants, does not state that its composition can be provided in granule form, the Chan reference indicates at the paragraph bridging columns 12 and 13 that a composition similar to one shown by Yukikazu can be formulated as wettable powders or granular formulations. Note also that both the compositions of Yukikazu and Chan can be broadly categorized as pesticidal compositions. Moreover, we observe that appellants acknowledge that "it has already been known that solid pesticides can be formulated into water dispersible granules." See specification, page 1, lines 15-18. Since wettable powders containing insecticides are in solid form and since granules and powders are conventional forms by which pesticides, inclusive of insecticides, are used, Yukikazu and Chan as a whole would have suggested to one of ordinary skill in the art to provide the insecticide composition of the type described by Yukikazu in the known forms, such as granules. This is especially true in the present case since simple observation by the skilled artisan would have revealed that wettable powders would scatter away

Appeal No. 94-4145
Application No. 07/882,252

under windy conditions due to their weight. See In re Ludwig, 353 F.2d 241, 244, 147 USPQ 420, 421 (CCPA 1965). Increasing the weight of solid powders by making them dense, i.e., providing them in the form of granules, for the purposes of improving the handling of the insecticide composition described by Yukikazu would have been within the level of one of ordinary skill in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Appellants refer to the showings in the Ogawa declarations filed under 37 CFR § 1.132 and the examples at pages 28-29 of the specification, which are supposedly directed to a comparison between the claimed subject matter and the closest prior art. See Brief, page 5, and Reply Brief, page 2. According to appellants, the showings demonstrate that the claimed granulates have better solubility and suspension properties. See Brief, page 5. It appears that appellants are relying on the showings to establish that the claimed subject matter imparts unexpected properties over that described in the closest prior art.

In assessing the sufficiency of the showings in the

Appeal No. 94-4145
Application No. 07/882,252

Ogawa declarations and the examples at pages 28-29 of the specification, we are mindful that appellants have the burden of proof. See In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972); In re Heyna, 360 F.2d 222, 228, 149 USPQ 692, 697 (CCPA 1966). Upon making a factual, evidentiary inquiry, see In re Johnson, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984), we are convinced that appellants have not met their burden.

We initially note that the claimed subject matter is not compared with the closest prior art. See In re Baxter Travenol Labs, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). From our perspective, the closest prior art is the Yukikazu reference since it is directed to an insecticide composition which has the same ingredients as that claimed. Appellants have not explained why the comparative example in the Ogawa declarations is closer than that shown in the Yukikazu reference.

We also note that the showings in the examples at pages 28-29 of the specification are not reasonably commensurate in scope with the degree of protection sought by the appealed

Appeal No. 94-4145
Application No. 07/882,252

claims. See In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990). While the showings in the examples at pages 28-29 of the specification are limited to employing particular amounts of specific pesticides, specific calcined silicon dioxides, specific surfactant and optionally specific additional ingredients, the appealed claims are not so limited. Appellants, however, have not offered any evidence to support the conclusion that the demonstrated results based on limited examples can reasonably be extrapolated to the plethora of pesticide compositions having multifarious ingredients embraced by the appealed claims.

Moreover, appellants have not made any averments in the specification that the demonstrated results referred to are "unexpected". Nor did appellants submit such averments through the Ogawa declarations. Accordingly, appellants cannot be said to have established that the demonstrated results are "unexpected". See In re Geisler, 116 F.3d 1465, 1471, 43 USPQ 1362, 1366 (Fed. Cir. 1997).

Thus, having considered all of the evidence of record, we determine that the evidence of obviousness, on balance, outweighs the evidence of unobviousness. Hence, we agree with

Appeal No. 94-4145
Application No. 07/882,252

the examiner's conclusion that the subject matter defined by claims 1 through 5 would have been obvious to one of ordinary skill in the art. Thus, we affirm the examiner's decision to reject claims 1 through 5 under 35 U.S.C. § 103.

Our affirmance of the examiner's rejection of one or more claims contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Appeal No. 94-4145
Application No. 07/882,252

37 CFR § 1.196(b) provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned

Appeal No. 94-4145
Application No. 07/882,252

to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CAMERON WEIFFENBACH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHUNG K. PAK)	
Administrative Patent Judge)	

Appeal No. 94-4145
Application No. 07/882,252

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Appeal No. 94-4145
Application No. 07/882,252

CKP/jrg

APPEAL NO. 94-4145 - JUDGE PAK
APPLICATION NO. 07/882,252

APJ PAK

APJ SMITH, JOHN D.

APJ WEIFFENBACH

DECISION: **AFFIRMED § 1.196(b)**

Typed By: Jenine Gillis

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Revision: 26 Jan 98

FINAL TYPED: